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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/030,162	04/25/2002	Albert Modl	MODL3003/JEK	4361

23364 7590 12/20/2006  
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EXAMINER

HO, THOMAS M

ART UNIT PAPER NUMBER

2132

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	12/20/2006	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/030,162	<b>Applicant(s)</b> MODL ET AL.	
	<b>Examiner</b> Thomas M. Ho	<b>Art Unit</b> 2132	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 September 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-3 is/are allowed.
- 6) ☒ Claim(s) 4-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| <p>1) <input type="checkbox"/> Notice of References Cited (PTO-892)</p> <p>2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)</p> <p>3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br/>Paper No(s)/Mail Date _____.</p> | <p>4) <input checked="" type="checkbox"/> Interview Summary (PTO-413)<br/>Paper No(s)/Mail Date. <u>8/29/06</u></p> <p>5) <input type="checkbox"/> Notice of Informal Patent Application</p> <p>6) <input type="checkbox"/> Other: _____.</p> |
|---|---|

### **DETAILED ACTION**

1. Claims 1-9 are pending.
2. The RCE of 9/28/06 has been received and entered.

#### ***Response to Amendments***

3. The Applicant has amended claim 1 in accordance with that which was discussed in the interview of 8/29/06.

Accordingly claim 1 and its independent claims have overcome the art of record. The rejection under 35 USC 103 has been withdrawn.

Applicant has also argued with respect to claims 4 and 7. The Examiner contends however that Boerbert does indeed display the secret code as recited in Figure 4, Item 128. It is understood from the art of Boerbert that the display is presented by a data terminal. Furthermore, this terminal would be unable to present this display if it were not recognized by the system as being authorized to do so. Claims 4 and 7 do not contain the subject matter of claim 1 that renders them allowable. Applicant has chosen not to amend this limitation into claim 1. For this reason, the rejections to claims 4 and 7 are maintained for the reasons below.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 4-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Boerbert, US patent 5,272,754.

In reference to claim 4:

Boerbert discloses a data carrier for authenticating a user of the data carrier and for authenticating a data carrier terminal for accessing the data carrier (Column 2, lines 17-24, 37-45) & Figure 4, comprising a first memory area in which a secret code(CODE) is stored such that the secret code can be read and decrypted and displayed only by an authorized data carrier terminal to authenticate the data carrier terminal for accessing the data carrier (Column 5, lines 10-26) & (Column 4, line 48 – Column 5, line 11) & (Column 7, line 52 – Column 8, line 2), and a second memory area in which data are stored which serve to authenticate the user for authorized use of the data carrier. (Figure 2) & (Figure 4, Item 114) & (Column 5, lines 10-25)

In reference to claim 5:

Boerbert (Column 9, line 57 – Column 10, line 11) discloses a data carrier according to claim 4, wherein a PIN is stored in a third memory area.

In reference to claim 6:

Boerbert (Column 7, lines 40-46) discloses a data carrier according to either of claims 4 and 5, wherein the biometric data are generated by a fingerprint.

In reference to claim 7:

An authentication system comprising a data carrier with memory areas and a data carrier terminal for accessing the memory areas of the data carrier, wherein

- The data carrier has a first memory area for storing a secret code (Column 5, lines 10-25) and a second memory area for storing biometric data. (Column 7, lines 40-46)
- The data carrier terminal has a first device which is authorized for reading the secret code from the first memory area and for decrypting the read secret code and for presenting the read secret code on a display, where the code is the token information. (Figure 4, Items 100, 102), and where the token information is read by the terminal and decrypted (Column 5, lines 10-26) & (Column 4, line 48 – Column 5, line 11) & (Column 7, line 52 – Column 8, line 2),

Boerbert fails to explicitly disclose

- A device for comparing the read biometric data (BIO) with biometric data stored in the second memory area in the data carrier (C) and/or in the terminal (T).
- and a second device for reading biometric data (BIO) of a biometric feature presented by a user.

Boerbert however discloses that in an alternate embodiment, the user authentication device can include a biometric device, which would then be sent to a computer during the user verification process described in Fig 4. (Column 7, lines 40-46)

It is shown in Figure 4, that the invention of Boerbert verifies the authentication information at Items 114. (Column 10, lines 1-10) discloses the computer 60 checks the authentication information for correctness.

It would have been obvious to one of ordinary skill in the art to compare the presented biometric information in order to verify it in order to authenticate the user based on biometric information.

In reference to claim 8:

Boerbert (Column 9, line 57 – Column 10, line 11) discloses an authentication system according to claim 7, wherein the data carrier has a third memory area for storing a PIN.

In reference to claim 9:

Boerbert (Column 7, lines 40-46) discloses an authentication system according to claim 7 or 8, wherein the stored biometric data are generated by a fingerprint.

### ***Conclusion***

6. Any inquiry concerning this communication from the examiner should be directed to Thomas M Ho whose telephone number is (571)272-3835. The examiner can normally be reached on M-F from 9:30 AM - 6:00 PM.

Art Unit: 2132

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor,

Gilberto Barron can be reached on **(571)272-3799**.

The Examiner may also be reached through email through Thomas.Ho6@uspto.gov

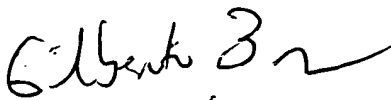
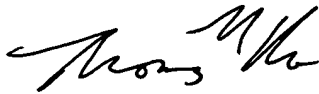
Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571)272-2100.

General Information/Receptionist Telephone: 571-272-2100 Fax: 571-273-8300

Customer Service Representative Telephone: 571-272-2100 Fax: 571-273-8300

TMH

December 11<sup>th</sup>, 2006



GILBERTO BARRÓN JR  
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